

## **REMARKS / ARGUMENTS**

### ***Remaining Claims***

Applicants affirm the provisional election to prosecute the invention of claims 1-37 made on September 17, 2004. In light of the election and the present amendments and cancellations, Claim 1-34 remain pending in this application. Applicants have cancelled claims 35-47. Applicants note that the Examiner objected to claims 5-8, 11, 12, and 25-31.

### ***Rejection under 35 U.S.C. 102 (a)***

The Examiner rejected claims 35-37 under 35 U.S.C. 102(a) as being anticipated by Yang, et al., U.S. Patent no. 6,042,754 (the '754 patent). Claims 35-27 have been cancelled by this amendment; hence the rejections are moot. Applicants respectfully request that these rejections be reconsidered and withdrawn.

### ***Rejections under 35 U.S.C. 103 (a)***

The Examiner rejected claim 1 under 35 U.S.C. 103 (a) as being unpatentable over the '754 reference. Claim 1, among other things, requires "moving the first and the second mold parts together to form a mold cavity between the opposing front curve molding surface and back curve molding surface with the polymer therebetween, the mold cavity defining a shape of an ophthalmic lens having a variable volume between a first volume and a second volume, the second volume being greater than the first volume, wherein the mold parts have sufficiently small clearance such that gas escapes from the mold cavity and none of the polymer escapes from the mold cavity..." As stated in the MPEP at 706.02(j), to establish a prima facie case of obviousness the "prior art reference (or references combined) must teach or suggest all the claim limitations." The '754 patent does not teach mold parts that allow gas to escape from the mold cavity while none of the polymer escapes from the mold cavity. Rather, the '754 patent states that "Excess polymer distributed between adjacent dies will be broken by the edge of the upper dies and be pushed out and removed by, for example, a rod operated by an air cylinder located under the piece of the excess polymer material." See '754 patent at Col.10, lines 34-38. Because the '754 patent does not teach or suggest mold parts having sufficiently small clearance such that gas escapes from the mold cavity and none of the polymer escapes from

the mold cavity, is cannot render the present application obvious. For this reason, Applicants respectfully request that this rejection be reconsidered and withdrawn.

The Examiner also rejected claims 2,3,9, 15-22, 24,32,and 33 under 35 U.S.C. 103(a) as being unpatentable over Yang et al. further in view of Hammar et al. 4,673,5439 (the '539 reference). Claims 2, 3, 9, 15-22, 24, 32, and 33 are all dependent from claim 1 and as such, incorporate the limitations found in claim 1. As stated above, the '754 patent does not teach or suggest mold parts having sufficiently small clearance such that gas escapes from the mold cavity and none of the polymer escapes from the mold cavity. The '539 patent does not remedy this deficiency. The '539 patent does not discuss polymer or gas escaping the mold cavity nor the existence of excess polymer. Hence, because neither Yang nor Hammar, nor their combination teaches or suggests mold parts having sufficiently small clearance such that gas escapes from the mold cavity and none of the polymer escapes from the mold cavity, they cannot render the current invention obvious. For this reason, Applicants respectfully requests that the present rejections be reconsidered and withdrawn.

The Examiner rejected claim 34 under 35 U.S.C. 103(a) in light of the foregoing references and further in view of Yamanaka et al. 6,099,765. The '765 reference doe not remedy the deficiencies of the '754 or '539 patents. As such, Applicants respectfully request that all of the outstanding rejections be reconsidered and withdrawn.

### **CONCLUSION**

In view of the foregoing amendments, cancellations and in conclusion, Applicants submit that the 35 USC § 102 and 103 rejections set-forth in the Office Action have been overcome, and that the pending claims are not anticipated by or obvious over the cited art, either individually or in combination. Applicants request reconsideration and withdrawal of the rejection(s) set-forth in the Office Action.

Should the Examiner believe that a discussion with Applicants' representative would further the prosecution of this application, the Examiner is respectfully invited to contact the undersigned. Please address all correspondence to Robert Gorman, CIBA Vision, Patent Department, 11460 Johns Creek Parkway, Duluth, GA 30097. The Commissioner is hereby authorized to charge any other fees which may be required under 37 C.F.R. §§1.16 and 1.17, or credit any overpayment, to Deposit Account No. 50-2965.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'KBorrelli', is written over a solid horizontal line.

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